

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Confirmation No. 3267

Application Serial No.: 10/072,672
Applicant : Eaton et al.
Filed : February 8, 2002
Title : System for Providing Continuity Between Session Clients and
Method Therefor
TC/A.U. : 2154
Examiner : Dustin Nguyen
Docket No. : PT03771U

**DECLARATION OF PRIOR INVENTION IN THE UNITED STATES BY DAVID J.
HAYES TO OVERCOME CITED PATENT OR PUBLICATION
UNDER 37 C.F.R. § 1.131**

I hereby declare as follows:

1. My name is David J. Hayes and I am one of three co-inventors of the invention claimed in the above-captioned patent application.
2. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true.
3. I am currently employed by Motorola, Inc. ("Motorola") at its facility in Plantation, Florida. At the time my co-inventors and I invented the subject matter claimed in the above-captioned application, I was employed by Motorola at its facility in Boynton Beach, Florida.
4. On December 7, 2005, the Examiner issued an Office Action in the above-captioned application in which the Examiner rejected claims 1, 4, 5, 8, 12-14, 16-26, 29, 30, 33, 40, 41, 44-47, and 53 under 35 U.S.C. § 102(e) based solely upon U.S. Patent Application Publication No. 2003/0055977 (hereinafter "Miller"), which is entitled "System for Automated, Mid-Session, User-Directed, Device-to-Device Session Transfer System" and was filed on September 17, 2001. The Examiner also rejected claims 6, 7, 9, 10, 28, 32, 37, 38, 42, 43, 48, 49, 51, 54, and 55 under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of U.S. Patent No. 5,948,040. The Examiner further rejected claims 11, 27, 31, 39, 50, and 52 under 35 U.S.C. §

103(a) as being unpatentable over Miller in view of U.S. Patent Application Publication No. 2005/0034161 (hereinafter "Brown"), which is entitled "Interactive System for Enabling TV Shopping," was filed on April 2, 2004, and claims priority upon International Application No. PCT/GB01/05448 filed December 10, 2001.

5. Prior to September 17, 2001, the earliest effective filing date of Miller, the sole U.S. patent reference relied upon by the Examiner to reject claims 1, 4, 5, 8, 12-14, 16-26, 29, 30, 33, 40, 41, 44-47, and 53 and the primary reference relied upon to reject claims 6, 7, 9, 10, 11, 27, 28, 31, 32, 37, 38, 39, 42, 43, 48, 49, 50-52, 54, and 55, Mr. Eric Eaton, Mr. Von Mock, and I conceived of, in the United States of America, the invention disclosed and claimed in U.S. Patent Application Serial No. 10/072,672. Mr. Eaton, Mr. Mock, and I disclosed our invention to Motorola's internal Intellectual Property Department/Technical Asset Management Office and used due diligence from prior to September 17, 2001 to work together with Motorola's internal Intellectual Property Department to prepare and file U.S. Patent Application Serial No. 10/072,672 directed to our invention.

6. In support of my assertion that Mr. Eaton, Mr. Mock, and I completed our invention, as defined by the claims of U.S. Patent Application Serial No. 10/072,672, in the United States of America prior to September 17, 2001, I submit herewith and attach hereto as Exhibit A a redacted photocopy of the Utility Disclosure for Patent Committee Review ("Utility Disclosure") that we prepared and submitted to the Intellectual Property Department/Technical Asset Management Office at Motorola's Boynton Beach, Florida facility before September 17, 2001. Exhibit A is a redacted photocopy because dates and confidential information irrelevant to the present application have been blocked off. All of the dates redacted in Exhibit A are before September 17, 2001, except that the date related to potential disclosure of the invention outside of Motorola and the date related to a potential offer for sale or shipment of a product embodying the present invention are less than one year prior to the filing date of the present application. The redacted dates include the date of receipt of the Utility Disclosure by Motorola's Intellectual Property Department, the Documentation Date, the date the invention was first disclosed to a non-inventor employee of Motorola, the dates of execution of the Utility Disclosure by the inventors and two witnesses, and the date identified in the header of the Utility Disclosure.

7. Notwithstanding that the Utility Disclosure indicates a proposed date for offering for sale and/or shipping a product embodying the invention that is the subject of the present application and a proposed date for disclosing the present invention outside of Motorola, no such offer for sale, sale, shipment, or disclosure ever took place prior to the filing date of U.S. Patent Application Serial No. 10/072,672.

8. The Utility Disclosure contains a written description of the subject matter claimed in U.S. Patent Application Serial No. 10/072,672 and establishes our conception of the invention defined by the claims of such application in the United States of America prior to September 17, 2001.

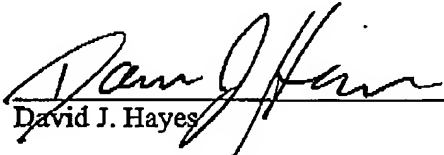
9. The Utility Disclosure also establishes our exercise of due diligence from prior to September 17, 2001 to prepare and file a United States patent application directed to the subject matter of our invention, which application was ultimately filed on February 8, 2002.

10. Based on the foregoing, it can be readily seen that Mr. Eaton, Mr. Mock and I conceived of our invention in the United States of America prior to September 17, 2001, the earliest effective date of Miller, and further used due diligence continuously from prior to September 17, 2001 through the filing date of U.S. Patent Application Serial No. 10/072,672 (i.e., February 8, 2002).

11. Based on the foregoing, it can also be readily seen that Mr. Eaton, Mr. Mock and I conceived of our invention in the United States of America prior to December 10, 2001, the earliest effective date of Brown, and further used due diligence continuously from prior to December 10, 2001 through the filing date of U.S. Patent Application Serial No. 10/072,672 (i.e., February 8, 2002).

12. This declaration is being submitted responsive to an Office Action dated December 7, 2005 and responsive to the Examiner's first citation and reliance upon Miller and/or Brown.

13. I hereby acknowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-captioned application or any patent issuing thereon.


David J. Hayes

Date: 3/28/06

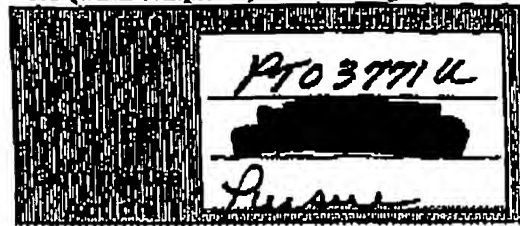
EXHIBIT A

MOTOROLA CONFIDENTIAL & PROPRIETARY (when completed)

Page 1

MOTOROLABOYNTON
BEACH

UTILITY Disclosure For Patent
Committee Review
Submitted Pursuant To
Employment Agreement

**THIS SECTION TO BE COMPLETED BY INVENTOR(S)**

1. Name of Invention: (Please limit to 10 words or less.) **AUCTION PASS**
2. Documentation Date: [REDACTED]
(Attach log sheets, drawings, etc., to support the earliest date you documented your idea.)
3. Whom did you first tell about your invention?
Name: **TOM QUIROGA** Date: [REDACTED]
4. Is this disclosure being submitted as an Ornamental Design Disclosure? Yes/No **NO**
If YES, please attach a completed Ornamental Design Disclosure Form along with this disclosure.
5. What problem is solved by this invention? (Attach additional sheets if necessary.) **Method to simply synchronize environments and communications capabilities for participation in an event from multiple devices.**
6. Identify related technology. (Attach additional sheets if necessary.) [REDACTED]
7. Describe the invention, and how it solves the problem(s) in a way not accomplished before.
Attach additional sheets describing the invention in detail. **SEE ATTACHED**

THIS SECTION TO BE COMPLETED BY ENGINEERING MGR OR HIGHER

1. Product invention is to be used on. (If a process, name the 1st product the process is to be used on.) [REDACTED]
2. This product will be (has been) offered for sale, quoted to a customer, or shipped. Yes/No **yes**
If YES, indicate the earliest date any of these will (have) occur(ed). [REDACTED]
3. This invention is to be (has been) disclosed outside Motorola: Yes/No **YES**
If YES, indicate the date [REDACTED] and the other party. [REDACTED]
4. Was a non-disclosure agreement in place covering the admitted disclosure? Yes/No **Yes**
5. Name of Engineering Manager (or higher) who attests to the accuracy of this section:
Typed: **TOM LAROTONDA**
Phone: **8348** Signature: [REDACTED] Date: [REDACTED]

**ALL BLANKS MUST BE COMPLETED AND ALL ADDITIONAL SHEETS MUST BE
SIGNED & DATED BY ALL INVENTORS AND TWO WITNESSES.**

MOTOROLA CONFIDENTIAL & PROPRIETARY (when completed)

Page 2

MOTOROLABOYNTON
BEACH

Utility Patent Disclosure

Auction Pass form.doc

Primary Inventor:**EATON**

Last Name:

ERIC

First Name:

THOMAS

Middle Name:

Social

Commerce

Security #

ID #

3198 MEDINAH CIRCLE EAST

Home Address: Street;

LAKE WORTH

City;

FL

State;

33467

Zip;

USA

Citizenship:

EU672 2909

Dept #: Office Phone #:

Location

FL-19**70**

Code:

MailStop:

1

Shift Status:

PERM

Employee

MORRIS MOORE

Immediate Supervisor:

INVENTOR'S FULL SIGNATURE

DATE

Inventor:**MOCK**

Last Name:

VON

First Name:

ALAN

Middle Name:

Social

Commerce

Security #

ID #

8114 ROSE MARIE CIRCLE

Home Address: Street;

BOYNTON BEACH

City;

FL

State;

33437

Zip;

USA

Citizenship:

EU247 3415

Dept #: Office Phone #:

Location

FL19**70**

Code:

MailStop:

1

Shift Status:

PERM

Employee

ERIC EATON

Immediate Supervisor:

INVENTOR'S FULL SIGNATURE

DATE

Inventor:**HAYES**

Last Name:

DAVID

First Name:

JEFFERY

Middle Name:

Social

Commerce

Security #

ID #

7544 WINTWORTH DR

Home Address: Street;

BOYNTON BEACH

City;

FL

State;

33467

Zip;

US

Citizenship:

EU247 2692

Dept #: Office Phone #:

Location

FL19**70**

Code:

MailStop:

1

Shift Status:

PERM

Employee

ERIC EATON

Immediate Supervisor:

INVENTOR'S FULL SIGNATURE

DATE

WITNESS NAMES & SIGNATURES:

The witnesses, in signing this form, attest to the fact that they understand the invention.

WITNESS NAME (PRINTED or TYPED)

PHONE

WITNESS SIGNATURE

DATE

MICHAEL PERONARD**8712***Michael Peronard***[REDACTED]**

WITNESS NAME (PRINTED or TYPED)

PHONE

WITNESS SIGNATURE

DATE

TOM LA TORRE**8348***Tom La Torre***[REDACTED]**More Inventors? Click [HERE](#) to make use of the [More Inventors](#) link.

[REDACTED]

Problem Solved:

When a consumer is participating in an auction it may last for hours or even several days. What is needed is an easy way to stay informed / involved about an item in an auction that the consumer has decided is important to him/her. The initialization of the short-range communication will be based on the IntelliDossier concept. The patentable features are in the user's experience during an Auction Pass.

Detailed Description:

The item of interest is indicated as a label under the [REDACTED] application under the "Auction Pass" folder. The navigation path to the item is linked to the item label. Once the user is interested in a specific item being auctioned they will go into the ID folder and select "Auction Pass". This will result in a path to the item, probably not the same as the one the consumer is currently using, and/or other required information to get back to this auction to be passed to the WAP enabled mobile device. The following information will be important to the consumer to be able to access the information.

- 1) The name of the item of interest
- 2) The item / auction id number
- 3) The navigation path to the item of interest
 - a. Could just indicate eBay auction and the mobile device would already know the path
- 4) The time in which the auction is over
- 5) Other general information item information

Now that the navigation path is stored in the Auction Pass folder the user can click on the item on the mobile device and be link to the auction. The Auction Pass Software will also have some auto features.

1) A delayed auto participate feature will launch the browser to the website via the mobile device just before the auction ends. 2) A delayed user aware alert would wait and notify the user that the application was actually able to take action on the auctioned item and not just in process of linking to the item. 3) If the auto participate launch is enabled it will not be launched if the mobile device is not located near the

Eric S. Linton
Van Wood

[REDACTED]

David J. Linton
Michael J. Linton

[REDACTED]

body (Motorola Patent Number 5956626) since there is no one to participate unless an auto bid program has been loaded and turned on. 4) If the device was not connected to the auction when it had expired go to the site and retrieve the final results or the application could be configured instead to automatically delete item from the Auction Pass Folder?

We also believe this kind of data is unique in that it is time and action sensitive and may have no value after the auction time has expired and no action can be taken. Therefore, if it is determined that no action can be taken in the auction the device will not go to the auction site.

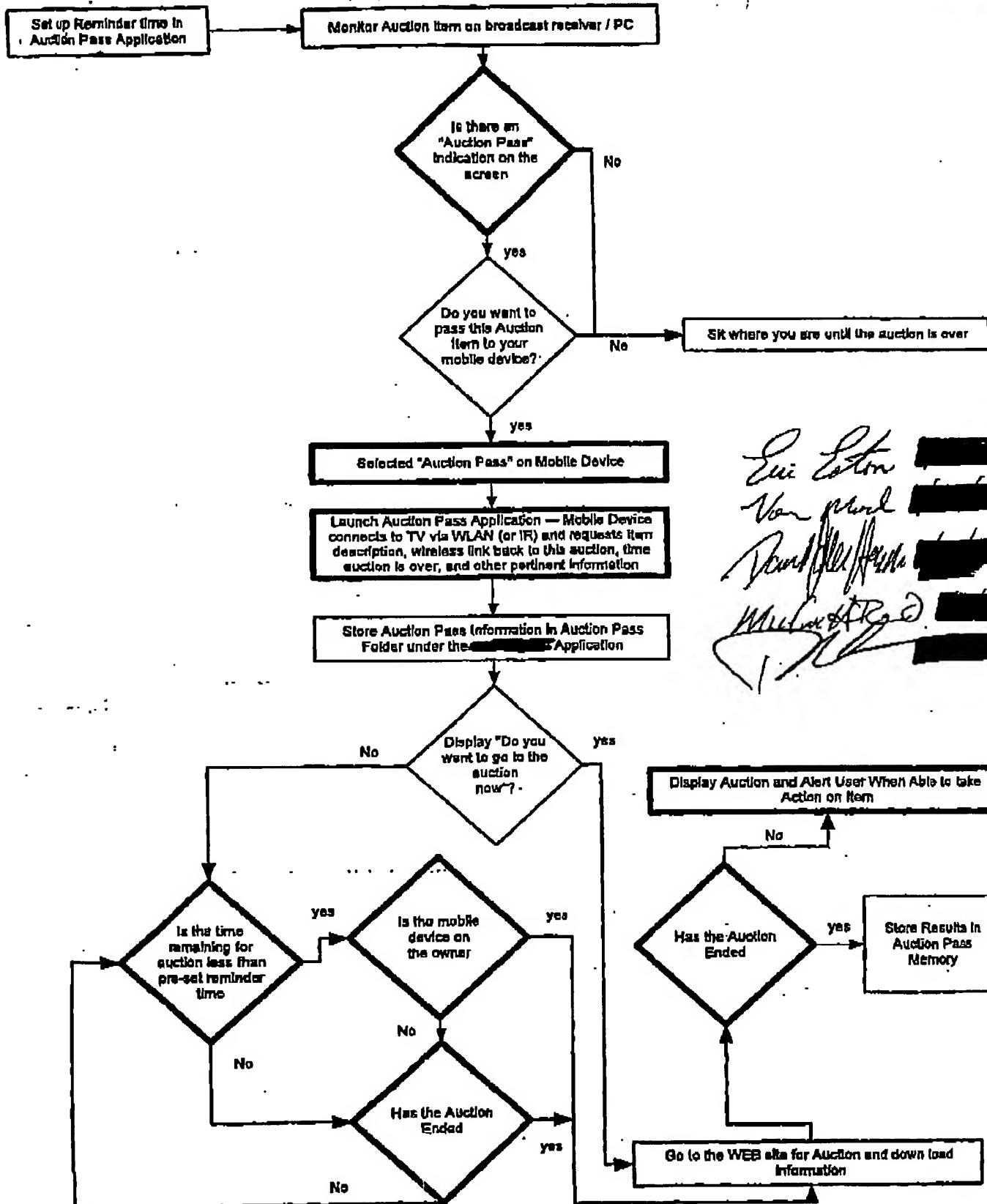
Claims: In context of the [REDACTED] Connection concept the following claims are desired.

- 1) Automatically launching the WAP browser to the auction site at a delayed time that is based off the auction ends time located on the auction site.
- 2) Automatically alerting the user only when the application is in position to bid
- 3) Do not connect to the WEB site if there is no one around to participate in the auction.
- 4) Automatically connect to the WEB and retrieve the final results of the auction after the auction has expired if the device was not connected to that item when the auction closed. Or Automatically deleting the link if the auctioned item has expired.
- 5) Making connection decision based on time / action relationships of information by not connecting to the web if there is no one to take action in the auction even if the auction timer has passed.

Eric Eaton [REDACTED]

Van [REDACTED]
[REDACTED]

James John Hays [REDACTED]
Michael [REDACTED]



**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.